

REMARKS/ARGUMENTS

Claims 1-38, 49-51, 60-75 and 77 are cancelled. Claims 39-48, 52-59, 76 and 78-80 remain pending in the application.

A clean copy of claim 54, as amended, follows:

54. An in vivo surgical method of cutting through cartilage, comprising:
providing a tissue remover cannula having a cannula axis extending between a cannula proximal end and a cannula distal end, an inner wall surface encompassing a cannula lumen, a fluid supply guide, and an electromagnetic energy transmitter;
positioning the cannula distal end into close proximity with the cartilage so that an interaction zone is defined between the cannula distal end and the cartilage;
transporting fluid to a distal end of the fluid supply guide and generating fluid in the interaction zone; and
propagating electromagnetic energy through the electromagnetic energy transmitter along a transmitter axis and into the interaction zone, the transmitter axis being (a) non-identical to, (b) non-overlapping with and (c) closer to the inner wall surface than the cannula axis;
the electromagnetic energy being substantially absorbed by a portion of the fluid in the interaction zone, the absorption of the electromagnetic energy by the portion of fluid causing the portion of fluid to expand; and
imparting disruptive cutting forces onto the cartilage in close proximity with the cannula distal end to thereby cut through the cartilage.

Regarding the obviousness rejections, the independent claim in this application recites, for example, an “in vivo surgical method of cutting through cartilage, comprising ... the transmitter axis being (a) non-identical to, (b) non-overlapping with and (c) closer to the inner wall surface than the cannula axis.” The claimed process is unique and provides unique results. It facilitates a unique rotational advancement through cartilage and hard tissue via generation of a “tunnel” sized (e.g., enlarged) to allow the cannula to be advanced, or to be more easily advanced, therethrough, or to be navigated, or more easily navigated, during or after the tunneling process.

The Examiner’s obviousness rejections do not even mention the above-quoted language of claim 1.

Judging from the Examiner’s silence on the quoted language, one might wonder whether he agrees with Applicants’ position that none of the prior-art references disclose, for

example, the above quoted limitations as currently included in the mentioned independent claim.

In any event, because of the above, the Examiner's rejections are lacking in **discussion and itemization** of all of the claim-term particulars. Applicants request that the Examiner discuss with particularity the limitations of each claim (independent **and dependent**) and state for the record how each and every limitation is met by prior art, with reference to a particular publication for each limitation and reference to the columns and line numbers in that publication for each claim limitation.

In general, the rejections of record, furthermore, are lacking in **facts and corroboration** in the nature of published evidence, such as documentation including source and column/line references to the facts/text (by way of prior art or Official Notice) being asserted or underlying such assertions, and such is earnestly requested and essential for the record. For instance, which reference of record discloses the above-quoted claim language?

It is well-established as set forth in, for example, In re Oetiker, (citation omitted) that "examiners ... must state clearly and specifically any objections ... to patentability, and give the applicant[s] **fair opportunity** to meet those objections with evidence and argument" (emphasis added). Applicants are at a loss on how to respond to the Examiner's general allegations that do not contain references to particular facts (in the text, e.g., by column/line references, of the prior art) that have been **made of record**. This concept of setting forth clearly for the record the basis of rejection(s) serves an important function of **leveling the playing field** and reducing the likelihood of administrative **arbitrariness**. For instance, the Office Action's only reasoning in support of the current prior-art rejection, namely, that "the application fails that ablation depth of greater" is unintelligible, and thus, cannot be addressed. The Examiner is requested to rephrase the subject prior-art rejections and their bases so that Applicants may respond. Applicants are hopeful that the Examiner can appreciate the necessity, and the benefit and apparent suitability, for providing a written basis for the record in support of the obviousness rejection of independent claim 1. Such a basis is **essential**, and is needed, at a minimum, to clarify the record and provide Applicant with an **opportunity to respond**.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejections based upon 35 U.S.C. § 103(a). In view of the above, Applicants submit that the application is now in condition for allowance, and an early indication of same is requested. Should the Examiner believe that a telephone conference with Applicants'

representative would be helpful to advance the prosecution of the application, or for any other reason, he is kindly invited to contact the undersigned with any questions.

The Commissioner is hereby authorized to charge any needed fees to Deposit Account 50-1600.

Respectfully submitted,



Kenton R. Mullins
Attorney for Applicants
Registration No. 36,331

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STOUT, UXA, BUYAN & MULLINS, LLP
4 Venture, Suite 300
Irvine, CA 92618
Tel: 949-450-1750
Fax: 949-450-1764